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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,042	03/25/2004	Andrew Michael Duggan	CRUI/0012	5804

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EXAMINER

WOLFE, DEBRA M

ART UNIT	PAPER NUMBER
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3725

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/809,042

Applicant(s)

DUGGAN ET AL.

Examiner

Debra Wolfe

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-19, 22, 23, 25, 29-26, 42-44, 49, 52, 5 and 63-65 is/are rejected.
- 7) ☒ Claim(s) 5 and 45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2004 & 27 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 20,21,24,26-28,37-41,46-48,51,54-62,66-72 and 74-89.



DETAILED ACTION

Election/Restrictions

Claims 71-89 are withdrawn from consideration as being drawn to a non-elected group. See Interview Summary with a mail date of September 13, 2006. Claims 37 and 38 are being withdrawn from consideration as being drawn to a non-elected species, although the claimed subject matter of these claims is incorporated by reference the elected species (FIGS 1,2 & 6) do not show a compliant expansion member. Claim 50 is withdrawn from consideration as being drawn to a non-elected species, the structure of the lockable compressive yield inducing expansion member pertains to figure 7 (species III). In addition, claims 56-60 and 66-70 are also withdrawn from consideration since they are drawn to a non-elected species. The embodiments of species 1 do not have compressive yield inducing expansion members that are skewed from the main axes of the tool in order to permit a drive force and do not have expansion members having a non-parallel axis with respect to a main axis of the device.

Priority

After review of Applicant's remarks filed on January 9, 2007 with regards to a priority benefit to US Application No. 10/618419, GB 0306774.1 and GB 0312278.5 the Examiner has concluded that not all claims are entitled to the priority benefit under 35 U.S.C. 119 or 120. The following is an explanation of which claims will receive the priority date of the parent and foreign applications:

1. The disclosure (paragraph 0008 line 10-15) of the parent application (10/618419) does not provide sufficient support for the structure of the hoop stress inducing expansion member and for limitations requiring the hoop stress to be performed after the compressive yield



expansion therefore only claims 1-4, 17-19, 42, 49, 52, 53, 56, 57, 59 and 63-65 are entitled to the filing date (07/11/2003) of the Parent application.

2. The disclosure (page 18 line 19) of foreign application GB 0306774.1 does not provide sufficient support for the structure of the compressive yield member except that it has at least one expansion member therefore only claims 1-5, 16, 22, 30-33, 35, 36, 49, 63-65 are entitled to the filing date (03/25/2003) of the foreign application.

3. The disclosure of foreign application GB 0316050.4 does provide adequate support for the claimed invention and therefore claims 1-19, 22, 23, 25, 29-38, 42-45, 49, 50, 52, 53, 56-60 and 63-70 are entitled to the filing date (07/09/2003) of the foreign application.

4. Applicant's remarks with regards to the claimed priority to foreign application GB 0312278.5 appear to be incorrect since it is citing the disclosure of foreign application GB 0316050.4 therefore none of the claims are entitled to the benefit of the filing date of application GB 0312278.5.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-4, 6-19, 22, 23, 25, 29-36, 42, 43, 49, 52, 53 and 63-65 rejected under 35 U.S.C. 102(b) as being anticipated by Metcalfe et al (US Patent # 6,543,552 B1). Metcalfe et al discloses an apparatus for lining a wellbore having an expansion device (20) having expansion members (42) adapted to expand a tubing by inducing a compressive yield and expansion



members (38) adapted to expand a tubing by inducing a hoop stress in the tubing such that the hoop stress expansion members (38) expands a tubing (18) to a first diameter and the compressive yield expansion members (42) expands the tubing to a second larger diameter. Metcalfe et al further discloses the hoop stress (32) and compressive yield (42) are arranged according to the desired post expansion diameter in the tubing (18) [See col. 3 lines 6-10] and are spaced alternately in an axial direction and a circumferential direction. The hoop stress inducing expansion member (38) and the compressive yield inducing expansion members (42) are provided on separate portions coupled together wherein a hoop stress inducing tool (30) carries the hoop stress expansion member (38) and the compressive yield inducing tool (32) carries the compressive yield expansion members (42) and are coupled by a swivel (34). The hoop stress inducing expansion member (38) are fixed relative to a remainder of the device (20) and are integrally formed with a body of the expansion device (20). The hoop stress members are rotatable with respect to the tubing and rotatably mounted on a body of the device (20). The compressive yield inducing expansion members (42) comprise of a rotary expansion member that rotates about an expansion axis. The compressive yield expansion members (42) are radially movable mounted with respect to the body of the device (20) for movement towards an expansion configuration by applied fluid pressure. The compressive yield inducing expansion members (42) is adapted to expand the tubing (18) by less than 50% or 25% or 10% of the total expansion of the tubing. It is noted that claims 2-4 and 14-19 do not further limit the structure of the expansion device but the disclosure of Simpson meets the required criteria of the claimed subject matter. [See FIGS 1-3 and col. 5 line 51 – col. 6 line 4]



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Metcalfe et al in view of Lauritzen et al (US Patent # 6,722,441 B2). Metcalfe et al discloses the invention substantially as claimed except for wherein the compressive yield expansion member is rotatably mounted on a spindle. However, Lauritzen discloses a compressive yield expansion member (416) rotatably mounted on a spindle (418) to permit rotation about a rotational axis. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the compressive yield expansion members of Metcalfe et al to be mounted on a spindle in order to permit rotation about a rotational axis.

Allowable Subject Matter

Claims 5 and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With regards to claim 5, although Metcalfe et al teaches of using other forms of expanders, such as a fixed cone or expansion mandrel, Metcalfe et al fails to teach or suggest changing the order of the expander sections such that the compressive yield member is the first expansion section and the hoop stress member is the second expansion section.



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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra Wolfe whose telephone number is (571) 272-1904. The examiner can normally be reached Monday - Thursday 7am - 4:30pm with alternating Friday 7am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Debra Wolfe
Examiner
Art Unit 3725

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
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